

The opinion in support of the decision being entered today was **not** written
for publication and is **not** binding precedent of the Board.

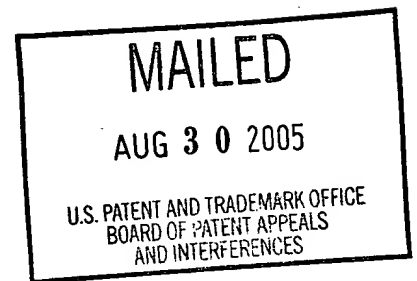
UNITED STATES PATENT AND TRADEMARK OFFICE

**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Ex parte ANIL V. RAO and WAYNE R. WEILNAU

Appeal No. 2005-1228
Application No. 09/271,581

ON BRIEF



Before DIXON, GROSS, and LEVY, **Administrative Patent Judges.**

DIXON, **Administrative Patent Judge.**

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 1-28,
which are all of the claims pending in this application.

**We REVERSE AND ENTER A NEW GROUNDS OF REJECTION UNDER
35 U.S.C. § 103.**

BACKGROUND

Appellants' invention relates to a system and method for installing system manufacturer provided software. A copy of representative claim 1 is set forth below.

1. A method of selectively installing software onto a computer system manufactured by a computer system manufacturer, said method comprising:

reading a configuration file that contains computer system information, the computer system information including manufacturer specific identification information identifying the computer system manufacturer;

determining an encrypted key from one or more bytes from the configuration file including the manufacturer specific identification information;

deciphering data stored on a nonvolatile storage device using the key so as to ensure that the software is installed only on a computer system manufactured by the computer system manufacturer.

The prior art references of record relied upon by the examiner in rejecting the appealed claims are:

Kubota	5,034,980	Jul. 23, 1991
Patterson	6,389,541	May 14, 2002 (filed May 15, 1998)

Rather than reiterate the conflicting viewpoints advanced by the examiner and appellants regarding the above-noted rejections, we make reference to the answer (mailed Aug. 9, 2004) for the examiner's reasoning in support of the rejections, and to the brief (filed Jul. 23, 2004) and reply brief (filed Oct. 12, 2004) for the appellants' arguments thereagainst.

OPINION

In reaching our decision in this appeal, we have given careful consideration to appellants' specification and claims, to the applied prior art references, and to the respective positions articulated by appellants and the examiner. As a consequence of our review, we make the determinations which follow. Appellants have elected to group the claims into six separate groupings which correspond to the six independent claims. Therefore, we will select a single claim from each group, for which appellants have set forth separate arguments for patentability, as the representative claim. Only those arguments actually made by appellants have been considered in this decision. Arguments that appellants could have made but chose not to make in the brief have not been considered. We deem such arguments to be waived by appellants [see 37 CFR § 41.37(c)(1)(vii) effective September 13, 2004 replacing 37 CFR § 1.192(a)]. We will consider the appealed claims separately only to the extent separate arguments for patentability are presented. Any dependent claim not separately argued will stand or fall with its base claim. **Note In re King**, 801 F.2d 1324, 1325, 231 USPQ 136, 137 (Fed. Cir. 1986); **In re Sernaker**, 702 F.2d 989, 991, 217 USPQ 1, 3 (Fed. Cir. 1983). We address the claims in groupings that follow the order discussed in the brief.

35 U.S.C. § 102

A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.

Verdegaal Bros. Inc. v. Union Oil Co., 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir.), **cert. denied**, 484 U.S. 827 (1987). The inquiry as to whether a reference anticipates a claim must focus on what subject matter is encompassed by the claim and what subject matter is described by the reference. As set forth by the court in **Kalman v. Kimberly-Clark Corp.**, 713 F.2d 760, 772, 218 USPQ 781, 789 (Fed. Cir. 1983), **cert. denied**, 465 U.S. 1026 (1984), it is only necessary for the claims to "'read on' something disclosed in the reference, i.e., all limitations of the claim are found in the reference, or 'fully met' by it." While all elements of the claimed invention must appear in a single reference, additional references may be used to interpret the anticipating reference and to shed light on its meaning, particularly to those skilled in the art at the relevant time. **See Studiengesellschaft Kohle v. Dart Indus., Inc.**, 726 F.2d 724, 726-727, 220 USPQ 841, 842-843 (Fed. Cir. 1984).

Anticipation is established only when a single prior art reference discloses, expressly or under the principles of inherency, each and every element of a claimed invention as well as disclosing structure which is capable of performing the recited functional limitations. **RCA Corp. v. Applied Digital Data Systems, Inc.**, 730 F.2d 1440, 1444, 221 USPQ 385, 388 (Fed. Cir.); **cert. dismissed**, 468 U.S. 1228 (1984);

W.L. Gore and Associates, Inc. v. Garlock, Inc., 721 F.2d 1540, 1554, 220 USPQ 303, 313 (Fed. Cir. 1983), **cert. denied**, 469 U.S. 851 (1984).

We consider first the examiner's 35 U.S.C. § 102 rejection of independent claim 1 based upon the teachings of Kubota alone. We note that the teachings of Kubota are quite good with respect to the problems and solutions which appellants also encounter, yet we do not find that the teachings of Kubota teach all of the limitations as recited in independent claim 1. Appellants argue that the claimed invention distinguishes from Kubota in that Kubota only stores information concerning the microprocessor and not a "computer system" and not "manufacturer specific identification information identifying the computer system manufacturer" and determining an encrypted key from one or more bytes from the configuration file.

Here, we cannot agree with the examiner that Kubota's teachings extend to the manufacturer of a computer system as recited in the claims. While we find that Kubota teaches the limitations of the process with respect to a microprocessor and Kubota teaches that the microprocessor will be used in a computer system, we cannot find that the stored information is an identification of a computer system manufacturer and that the information is stored in the configuration file. Therefore, we cannot sustain the rejection of independent claim 1. Similarly, we cannot sustain the rejection of independent claims 10 and 23 which contain similar limitations to independent claim 1

with respect to the storage of information including manufacturer specific identification identifying the computer system manufacturer.

35 U.S.C. § 103

With respect to independent claims 18, 20, and 22, the examiner maintains the same basis of the rejection based upon the teachings of Kubota, but adds the teachings of Patterson to teach and suggest the use of a registry file to store the key used for decrypting the software. Again, we find no teaching in either Kubota or Patterson of the storage of information which is an identification of a computer system manufacturer and that the information is stored in the configuration file and the examiner additionally maintains that Kubota teaches this limitation. We cannot agree with the examiner as discussed above. Therefore, we cannot sustain the rejection of independent claims 18, 20, and 22 and their dependent claims.

New Grounds of Rejection

Claims 1, 10, 18, 20, 22, and 23 are rejected under 35 U.S.C. § 103 as unpatentable over the combination of Kubota and Patterson. As discussed above, Kubota teaches the storage of information/key associated with a microprocessor which identifies the microprocessor and is used to decrypt encrypted software for use only by that microprocessor with a specific prestored key. We find this teaching to be a teaching of storing identification which would identify the manufacturer of the microprocessor. Similarly, we find this teaching of storing specific identification of the

microprocessor would have also been a specific identification of the manufacturer of the microprocessor akin to a Vehicle Identification Number (VIN) on an automobile.

Furthermore, we find the specific identification of the manufacturer of the microprocessor to readily suggest that any manufacturer information for any other components of the system or the overall system may be stored so as to limit the use of various software programs and other system modifications as disclosed and suggested by Kubota. (Kubota at column 3, lines 16-31.) Furthermore, we find that Kubota suggests the duplication of cipher codes for certain groups of computers when all will be used at the same location, such as, a school so that a group license for software may be used for all the computers in a classroom. (Kubota at col. 6, line 66-col. 7, line 5.)

With Kubota's specific suggestion that the identification information is typically used in the personal computer, we find this teaching to suggest that any application using a microprocessor could similarly code manufacturer information into the system. This code could either be hardcoded in the microprocessor at the time of manufacture or in the software which is used at the time of boot up, such as, in the BIOS. Most computers and components therein have identification information stored and used during the boot up of the computer. Therefore, we find that the teachings of Kubota teach or fairly suggest all of the claimed limitations but for the storage of the encryption key information in a configuration file and searching therein for the key.

As evidence of the well known use of the a configuration file or registry file in a Microsoft Windows Operating System, we rely upon the teachings of Patterson which clearly set forth the ordinary operation in the Windows system. Therefore, we find this to be a compelling suggestion of the location for the storage of encryption/decryption information which would also identify the manufacturer of the computer system. (Patterson at col. 3, lines 37-63.)

Appellants argue that providing manufacturer specific identification information identifying a computer system manufacturer is "patentably distinct from uniquely identifying a particular microprocessor as disclosed by Kubota." (Brief at page 8.) Appellants further argue that neither Kubota nor Patterson provides a disclosure relating to providing manufacturer specific information identifying a computer system manufacturer. (Brief at page 8.) While we agree with appellants that there is no express teaching concerning the overall computer system manufacturer, we find express suggestions in the disclosure of Kubota that modifications are within the level of skill in the art and we find express teachings of the incorporation of the microprocessors into computer systems and the plural computers/microprocessors can be coded similarly so as to allow group licenses for software. We find these extensions of the teachings of Kubota to suggest providing manufacturer specific information identifying a computer system manufacturer.

We have only applied the above modified rejection to the independent claims 1, 10, 18, 20, 22, and 23 and leave it to the examiner to evaluate the above modified rejection in light of the various other combinations of prior art references which the examiner applied against the claims previously.

This decision contains a new ground of rejection pursuant to 37 CFR § 41.50(b) (effective September 13, 2004, 69 Fed. Reg. 49960 (August 12, 2004), 1286 Off. Gaz. Pat. Office 21 (September 7, 2004)). 37 CFR § 41.50(b) provides "[a] new ground of rejection pursuant to this paragraph shall not be considered final for judicial review."

37 CFR § 41.50(b) also provides that the appellant, WITHIN TWO MONTHS FROM THE DATE OF THE DECISION, must exercise one of the following two options with respect to the new ground of rejection to avoid termination of the appeal as to the rejected claims:

(1) *Reopen prosecution*. Submit an appropriate amendment of the claims so rejected or new evidence relating to the claims so rejected, or both, and have the matter reconsidered by the examiner, in which event the proceeding will be remanded to the examiner. . . .

(2) *Request rehearing*. Request that the proceeding be reheard under § 41.52 by the Board upon the same record. . . .

CONCLUSION

To summarize, the decision of the examiner to reject claims 1, 5, 10, 13 and 23-28 under 35 U.S.C. § 102 is REVERSED, and the decision of the examiner to reject claims 2-4, 6-9, 11, 12, and 14-22 under 35 U.S.C. § 103 is REVERSED. We enter a new ground of rejection under 35 U.S.C. § 103 of independent claims 1, 10, 18, 20, 22 and 23.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a).

REVERSED and 37 CFR 41.50(b)

JOSEPH L. DIXON

JOSEPH L. DIXON
Administrative Patent Judge

Anita Pellman Gross

ANITA PELLMAN GROSS
Administrative Patent Judge

Stuart S. Levy
STUART S. LEVY

STUART S. LEVY 
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